UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,312	12/30/2003	Jessica R. DesNoyer	50623.313	1694

7590 09/01/2005

Cameron Kerrigan
Squire, Sanders & Dempsey L.L.P.
One Maritime Plaza, Suite 300
San Francisco, CA 94111

EXAMINER	
LAMB, BRENDA A	

ART UNIT	PAPER NUMBER
1734	

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/750,312	DESNOYER ET AL.	
	Examiner	Art Unit	
	Brenda A. Lamb	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 May 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) *2-3,10,12,15 and 26* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-9,11,13,14 and 16-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4/26/2004*.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Applicant's election of species as depicted in Figures 5A-5D and Figure 7A-7D in the reply filed on 5/25/2005 is acknowledged. It is noted that applicant has stated claims 1, 4-5, 9, 11, 13-14, 16-25 are readable on the elected specie. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The IDS of 4/26/2004 has been considered. Since it is not US practice to print patent application numbers on the front of US Patents, the references with patent application numbers on the IDS have been crossed thru.

Claims 16-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation in claim 17 that the mandrel body has one of the depicted configurations is improper since claims cannot refer to drawings (see 37 CFR 1.58). The recitation in claim 16 that the mandrel body has shape selected from the group consisting of configuration 2,3,4,5,6 or 7 is indefinite since it is unclear what the recited configuration encompasses.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 4-5, 9, 11, 13-14, 16-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Hattler et al 4,846,791.

Hattler et al teaches the design of a mandrel as depicted in Figures 3 and Figures 12- 13 to support a catheter or stent comprising a mandrel body capable of being inserted at least partially into a longitudinal bore of a stent, wherein the mandrel body having a shape within the scope of the claims 16-17. Hattler et al is capable of support the catheter or stent during application of coating thereon since it teaches every positively claimed element of the apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed

structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). With respect to claim 23, Hattler et al teaches in drawings which include Figures 12-13 a mandrel to support a catheter or stent comprising: a member to penetrate at least partially into a longitudinal bore of a stent, the member including outwardly projecting integral walls disposed around the circumference of the mandrel, wherein each of the walls converge with its neighboring wall at an angle. Hattler et al is capable of support the catheter or stent during application of coating thereon since it teaches every positively claimed element of the apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). With respect to claim 18, Hattler et al teaches in drawings which includes Figures 15a and 16 a mandrel to support a catheter or stent comprising: a member to penetrate at least partially into a longitudinal bore of a stent, the member including 3 pairs of opposing parallel sides (the opposing sides from the opposing triangles of the above cited mandrels). Hattler et al is capable of support the catheter or stent during application of coating thereon since it teaches every positively claimed element of the apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). With respect to claims 20-22, Hattler et al teaches as depicted in the drawings which include Figure 3 the design of a mandrel to support a catheter or stent comprising: a core section having

at least three sides and a wall extending from each of the sides in an outwardly direction. Hattler et al shows the walls are triangular in cross section and core have a shape within the scope of the claims. Hattler et al is capable of support the catheter or stent during application of coating thereon since it teaches every positively claimed element of the apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). With respect to claim 19, Hattler et al teaches as depicted in the drawings which includes Figure 16 the design of a mandrel to support a catheter or stent comprising: a member to penetrate at least partially into a longitudinal bore of a stent during the application of a coating substance, the member including 6 sides and each side wall surface is non-parallel with its neighboring side wall surface. Hattler et al is capable of support the catheter or stent during application of coating thereon since it teaches every positively claimed element of the apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). With respect to claims 9, 11 and 13-14, Hattler et al teaches the divider extends the entire length of the catheter or stent (see column 4 lines 64-66). Hattler et al shows the member may include integrally formed walls that have a shape and length within the scope of the claims (see Figures 12-13 and 16). Hattler et al is capable of support the catheter or stent during application of

coating thereon since it teaches every positively claimed element of the apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). With respect to claims 1, 4-5 and 24-25, Hattler et al shows as depicted in Figures 1-3 a stent mandrel fixture to support a catheter or stent comprising: a first member (protrusions arranged at one end of the mandrel) to contact a first end of the stent; a second member (protrusions arranged at the opposite end of the mandrel) to contact a second end of the stent; and a third member connecting the first member to the second member and extending through a longitudinal bore of the stent, the third member having at least least three walls 34 and these wall 34 are shaped and/or sized to substantially prevent a coating from being formed on a luminal surface of the catheter or stent. Hattler et al shows the third member has a plurality if spikes and these spikes contact the luminal surface. Hattler et al teaches the divider extends the entire length of the catheter or stent (see column 4 lines 64-66). Hattler et al is capable of support the catheter or stent during application of coating thereon since it teaches every positively claimed element of the apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987).

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hattler et al.

Hattler et al is applied for the reasons noted above. Hattler et al fails to teach the cross-section of the third member is within the scope of claims 7-8. Hattler et al teaches the third member can have shapes other than triangular such as cross-shaped or star-shaped. However, it would have been obvious to modify the Hattler et al mandrel by providing the third member with a shape within the scope of claims 7-8 since Hattler et al teaches the third member can have shapes other than triangular such as cross-shaped or star-shaped obviously to provide greater support of the catheter or stent. With respect to claim 6, Hattler et al fails to teach that the spikes do not contact the luminal of the stent or catheter. Hattler et al teaches that the geometry of the divider may or may not require protrusions to provide support necessary to prevent collapse of the lumen within the catheter or stent. Therefore it would have been obvious to modify the Hattler et al mandrel such that the spikes of the third member do not have to touch or contact the luminal of the stent as long as the number of protrusions on the third member are sufficient to prevent collapse of the luminal within the catheter or stent for the obvious reason of providing a plurality of discrete support points – enable one to continued support for the catheter despite wear of the one of the discrete protrusions.

Any inquiry concerning this communication should be directed to Brenda A. Lamb at telephone number (571) 272-1231. The examiner can normally be reached on Monday and Wednesday thru Friday with alternate Tuesdays off.

Brenda A Lamb
Examiner
Art Unit 1734